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§ Group Art Unit: 2183
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§ Examiner: Treat, William M.
§
§ Atty. Dkt. No.: 5181-10802

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THE UNIVERSITY OF CHICAGO

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RELATED APPEALS AND INTERFERENCES

As noted in Appellants Reply Brief, a related appeal has also been filed for reissue application no. 09/159,509 owned by the same assignee as the present application. Examiner Treat is the Examiner for both the present application and for application no. 09/159,509. Both applications involve similar interpretations of the recapture doctrine by Examiner Treat.

RESPONSE TO THE BOARD'S ORDER

In the Order of May 6, 2002, the Board required Appellants to provide this Supplemental Appeal Brief to specifically address two issues: i) the impact of the decision in *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597 (Fed. Cir. 2001) on the rejection at issue in this appeal, and ii) the rejection of claims 1 to 94 under U.S.C. § 251 as being based on a defective reissue declaration.

Appellants would first note that a Reply Brief was filed on March 6, 2002, and again faxed to Mr. Dale Shaw at the Board of Patent Appeals and Interferences on April 29, 2002. The Reply Brief at least partially addresses both of these issues. A more specific briefing of these two issues is provided below.

1. The Pannu Decision

The recent decision in *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597 (Fed. Cir. 2001) is consistent with the prior body of case law governing the recapture rule. The *Pannu* court states a three-step process for applying the recapture rule. *See Id.* at 1600 (citing *Hester Indus., Inc. v. Stein, Inc.*, 46 USPQ2d 1641, 1649-50 (Fed. Cir. 1998) and *In re Clement*, 45 USPQ2d 1161, 1164-65 (Fed. Cir. 1997)). The first step is to “determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims.” “The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter.” Finally, it must be determined whether the

reissue claims are materially narrower in other respects to avoid the recapture rule. *Pannu*, 59 USPQ2d at 1600.

The second step of the three-step *Pannu* process is “to determine whether the broader aspects of the reissued claim related to surrendered subject matter.” *Id.* (quoting *Clement*, 45 USPQ2d at 1164). This determination is based on the subject matter that the applicant admitted was not in fact patentable during prosecution of the original application. *See Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 221 USPQ 568, 574 (Fed. Cir. 1984). Cancellation or amendment of a claim during the original prosecution is an indication that “the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable.” *Clement*, 45 USPQ2d at 1164 (emphasis added).

Thus, broader aspects of a reissue claim only relate to surrendered subject matter if the reissue claim encompasses the surrendered subject matter. This may be determined by “[c]omparing the reissue claim with the cancelled claim.” *Id.* The proper question for recapture is “whether the [reissue] claims are of the same scope as the cancelled claims, not whether they lack some specific recitation absent from the cancelled claims but included in the patent claims.” *In re Richman*, 161 USPQ 359, 362 (C.C.P.A. 1969). “If the scope of the reissue claim is the same as or broader than that of the cancelled claim, then the patentee is clearly attempting to recapture surrendered subject matter.” *Clement*, 45 USPQ2d at 1164. “In contrast, a reissue claim narrower in scope escapes the recapture rule entirely.” *Id.* at 1165. Similarly, “if the reissue claim is narrower [than the surrendered claim] in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim. *Id.* Therefore, the recapture rule does not apply under the second step of the *Pannu* process if the reissue claim, although broader than the patented claims, is narrower than the surrendered claim in an aspect germane to prior art rejection (i.e. materially narrower). This is true even if the reissue claim is broader than the surrendered claim in other aspects, as long as it is

narrower than the surrendered claim in an aspect germane to prior art rejection. *Clement*, 45 USPQ2d at 1165.

Thus, recapture does not apply if a patentee realizes that through error he amended his claim more narrowly than was required. This principle in regard to the recapture rule was stated in *Richman*, 161 USPQ at 363 as: “Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature ... would have been sufficient to render the claims patentable over the prior art.” For example, in *Ex parte Lombard*, 47 USPQ 523 (Patent Office Board of Appeals 1940) the applicant amended his claims to obtain allowance by specifying that a particular layer in a claim for a shoe extends “throughout the entire area of the sole.” The surrendered claim (i.e. the claim prior to this amendment) was not limited to the layer extending throughout the entire area of the sole. The reissue claim recited that the layer extended “throughout at least the entire area of the forepart of the sole.” Thus, the reissue claim was broader than the patent claim but narrower than the surrendered claim in regard to the very claim aspect that was germane to the rejection during the original prosecution. The Board held that the applicant was entitled to the reissue claim. To put it in terms of *Pannu*, while the applicant would not have been allowed to recapture the “precise” limitation added to overcome prior art, he was allowed to recapture an intermediate scope. In the present case on appeal, the Examiner’s application of the recapture rule is clearly at odds with the case law.

Even if recapture is found under the second step of the *Pannu* process, the recapture rule can still be avoided under the third step of the *Pannu* process if “the reissued claims were materially narrowed in other respects.” *Pannu*, 59 USPQ2d at 1600. For example, the recapture rule may be avoided if “the reissue claims are materially narrower in other overlooked aspects of the invention.” *Hester*, 46 USPQ2d at 1649-50. Another example is found in *Ball Corp. v. United States*, 221 USPQ 289 (Fed. Cir. 1984) where the reissue claims omitted the specific limitation that had originally been added to the claim at the Examiner’s suggestion to obtain allowance. *Id.* at 291-93. However, the

reissue claims were narrowed in other respects such that the Federal Circuit held that the recapture rule did not apply. *Id.* at 295-96. See also *Richman* at 363 (“Certainly one might err without deceptive intention in adding a particular limitation where ... an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.”).

In *Pannu*, the court held that the patentee in that case “is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.” *Pannu*, 59 USPQ2d at 1601. In other words, the patentee was estopped from reverting his reissue claim back to the original surrendered claim without otherwise narrowing the reissue claim in some other material aspect. For the specific facts of *Pannu*, recapture was found under the second step and was not avoided under the third step of the three-step process because “the reissue claims were not narrowed in any material respect compared with their broadening.” *Id.*

When the three-step *Pannu* process is applied to the present reissue claims, it is clear that the recapture rule does not apply. For the present reissue claims, recapture is not found under the second step of the *Pannu* process. As discussed above, the reissue claims should be compared to the surrendered claims. Here, the surrendered claims are represented by the original application claims 1, 26 and 30 prior to the amendment of March 8, 1996 (these surrendered claims are repeated on pp. 7-8 of Appellants’ Reply Brief). The prosecution history of the original application reveals that the focus of Applicants’ amendments and arguments was to distinguish from the cited art by further defining the emulating means of claims 1 and 26 and the constructing step of claim 30. Independent claims 31, 66, 72, 77, 90 and 94 in the present reissue application all include additional definition of the corresponding emulating or constructing elements beyond what was present in the surrendered claims (i.e. original claims before amendment). For example, all of the independent claims in the present reissue application refer to emulating a body in a three-dimensional environment by changing one or more attributes of a cursor, wherein the cursor comprises a plurality of nodes configured as a point

hierarchy. This limitation is clearly germane to the rejection in the original application. Furthermore, this limitation was not present in the surrendered (original) claims. Since the present claims are narrower than the original claims in a manner germane to the original rejection, the recapture rule does not apply.

The aspects by which the reissue application claims are broader than the surrendered claims are not material to the rejection in the original application. For example, some of the reissue application claims are broader than the surrendered claims in that they are presented in a method format, computer-readable medium format or kit format as opposed to an apparatus format. However, a change in claim format is not considered to be a material difference. M.P.E.P. § 1412.02. Also, some of the reissue claims refer to processing data from body sensors as opposed to the body sensing means of original claim 1. However, this claim element was never material to overcoming the rejection during the original prosecution. No aspect of the “body sensing means” was argued to distinguish from the prior art. Since Applicants made no admission that any aspect of the “body sensing means” was required to overcome the rejection, the recapture rule does not apply. *Seattle Box*, 221 USPQ at 574. Similarly, some of the reissue claims refer to positioning the cursors within the virtual environment and integrating the cursors into a database for the virtual environment, as opposed to the modeling means and integrating means of original claim 1. But again, these elements were never at issue in the original prosecution. As discussed above, “if the reissue claim is narrower [than the surrendered claims] in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.” *Clement*, 45 USPQ2d at 1165.

Even if the reissue claims were considered to be broader than the surrendered claims in a material aspect, the recapture rule would still be avoided under the third step of the *Pannu* process because all of the reissue claims have been materially narrowed by inclusion of the material limitation discussed above (emulating a body in a three-dimensional environment by changing one or more attributes of a cursor, wherein the

cursor comprises a plurality of nodes configured as a point hierarchy). “Reissue claims that are broader in certain aspects and narrower in others may avoid the effect of the recapture rule.” *Mentor*, 27 USPQ2d at 1525. For example, in *Ball* the reissue claims omitted a material limitation but were narrowed in another material aspect such that the recapture rule did not apply. *Ball*, 221 USPQ at 295-96.

Appellants also assert that the Examiner has failed to state a *prima facie* rejection for each claim according to the recapture rule as stated in *Pannu*. In his rejection the Examiner only referred to the “emulate the first body...” and “emulate the second body...” elements found in some of Appellants’ independent claims. For none of the claims did the Examiner identify how each step of the recapture rule was met. The Examiner only made vague references to broadening and did not identify the specific broader aspects. Nor does the Examiner explain for each claim how any broader aspects relate to surrendered subject matter. For example, independent claim 94 contains almost the exact wording of the amendment made during the prosecution of the original application, yet the Examiner provides absolutely no explanation of how the recapture rule could possibly apply to claim 94. Clearly the analysis of the recapture rule for claim 94 is different than the analysis for claim 31, for example. However, the Examiner failed to separately analyze the claims. Instead the Examiner merely makes a bald assertion that material limitations from claims 1, 26 and 30 of the patent have been dropped in claims 31-94. Finally, the Examiner failed to properly apply the third step of the recapture rule by failing to analyze for each claim whether the reissue claims were materially narrowed so as to avoid the recapture rule. The third step of the *Pannu* process requires that the Examiner “must” determine whether the reissue claims are materially narrower in other respects to avoid the recapture rule. *Pannu*, 59 USPQ2d at 1600.

Under the third step of *Pannu*, even if one of the independent claims was impermissibly broadened in regard to a specific aspect, one or more of the dependent claims may include that aspect to avoid recapture. The Examiner did state in regard to some, but not all, of the dependent claims that he believed the additional limitations to be

immaterial as well known or trivial. However, for most of the claim limitations, the Examiner did not provide any factual basis to back up his assertion that the additional limitations were immaterial. The Examiner has not provided a proper factual basis as to why each claim fails to avoid the recapture rule under the third step of *Pannu* as being sufficiently narrowed in some other aspect.

2. Reissue Declaration

In his Answer, the Examiner rejects claims 1-94 as being based on a defective reissue oath/declaration. Appellants assert that this rejection is a new ground of rejection not stated in the Final Rejection from which this appeal was taken. Therefore this rejection is improper under 37 CFR § 1.193(a)(2) which bars the Examiner from making a new ground of rejection in the examiner's answer.

Moreover, the reissue declaration properly states errors by which the patentees claimed less than they had a right to claim in the original patent and that these errors arose without deceptive intent. The Examiner's assertion that the reissue declaration is defective appears to be based on his belief that correction of the errors stated in the reissue declaration would constitute impermissible recapture of surrendered subject matter. However, as discussed in the section above, the new claims submitted to address the errors stated in the reissue declaration do not impermissibly recapture surrendered subject matter. "The patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims cancelled from the original application to obtain a patent." MPEP § 1412.02. Also, the patentee is free to acquire, through reissue, claims that are narrower than the cancelled (surrendered) claim in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection. *In re Clement*, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997); MPEP § 1412.02. As discussed in detail herein and in Appellants' other briefs, claims 31-94 are materially narrower than the claims that were surrendered during prosecution of the original application. Therefore, the recapture rule does not apply.

As Judge Rich stated in regard to recapture in *In re Richman*, 161 USPQ 359, 363 (C.C.P.A. 1969): "Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art." That is precisely the type of error that Appellants have stated in their reissue declaration. During the original prosecution, applicants added particular limitations where less specific limitations would have sufficed. Appellants noted this error in their reissue declaration and submitted new claims that are still materially narrower than the claim surrendered during the original prosecution, but broader than the patent claims. Appellants are not seeking to recapture the scope of the claims surrendered during the original prosecution. Appellants are only seeking to correct their error of claiming less than they had a right to claim. Thus, the reissue declaration is not defective.

CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-94 was erroneous, and reversal of the Examiner's decision is respectfully requested.

This Supplemental Appeal Brief is submitted in triplicate along with a return receipt postcard.

Respectfully submitted,



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